

## REMARKS

Applicants respectfully request reconsideration of the present application.

## CLAIMS STATUS

Claims 33, 35 and 38-40 are pending. Claim 38 is an independent claim.

## DOUBLE PATENTING REJECTION

Claims 33, 35, 38-40 stand rejected on the ground of non-statutory obviousness-type double patenting over claim 10 of U.S. patent no. 7,256,005. Applicants respectfully traverse.

### 1. SUMMARY OF APPLICANTS' JANUARY 9<sup>TH</sup> ARGUMENT

In the response filed January 9, 2009, Applicants submitted that the PTO should have applied a two-way obviousness test instead of the one way analysis used in the Office Action because the '005 patent was issued from an application that was filed later than the present application. On page 6 of the January 9<sup>th</sup> response, Applicants submitted that the PTO failed to establish a *prima facie* case of obviousness for claims of the '005 patent over the pending claims, which is required for the two-way obviousness test.

### 2. THE PTO'S REASONS FOR NOT ACCEPTING APPLICANTS' ARGUMENT

On page 2 of the Final Office Action dated April 17, 2009, the PTO indicated that Applicants' argument of January 9, 2009, "has not been found persuasive because the instant application and the U.S. PATENT 7,256,005 were filed on the same day (August 10, 2000)".

### 3. DEFICIENCY OF THE PTO'S REASONING

In response, Applicants submit that the reasons on which the PTO relies for indicating that Applicant's argument is unpersuasive do not stand up to the actual facts because the instant application and U.S. patent application no. 10/669,175, from which U.S. patent no. 7,256,005 was issued, **were not** filed on the same date.

Applicants respectfully submit that the term “later filed application” in the citation from MPEP § 804.II.B.1(b) on page 5 of the January 9<sup>th</sup> response refers not to an application having a later effective filing date, but to an application having a later **actual** filing date.

Applicants respectfully submit that U.S. patent application no. 10/669,175 (the ‘175 application), from which U.S. patent no. 7,256,005 was issued, has an **actual** filing date of **September 23, 2003**. On the other hand, the present application no. 10/031,145 was filed **January 17, 2002**, as a National Phase entry of PCT/US00/21732 filed **August 10, 2000**. Thus, Applicants respectfully submit that, although the ‘175 application is a continuation-in-part of the present application, the **actual** filing date of the ‘175 application is **later** than the **actual** filing date of the present application.

Applicants respectfully submit that even if, for argument’s sake only, the term “later filed application” did refer to an application having a later effective filing date, the ‘175 application would still be a later filed application with respect to the present application because claim 10 of the ‘005 patent, over which the pending claims stand rejected, does not have support in the present application and, thus, claim 10 of the ‘005 patent has an effective filing date of September 23, 2003, which is later than the effective filing date of the pending claims.

In sum, Applicants respectfully submit that because 1) the **actual** filing date of the ‘175 application is later than the **actual** filing date of the present application; 2) the claims of the ‘005 application could **not** have been filed in the present application because the present application does not provide a written description support for the claims of the ‘005 patent; and 3) an administrative delay in prosecution of the present application indeed did occur and not through the fault of the Applicant, the PTO has to apply in its analysis for the double patenting rejection a **two-way obviousness test**, which must include establishing a *prima facie* case of obviousness for the claims of the ‘005 patent over the pending claims. Since the PTO failed to establish such a *prima facie* case of obviousness, Applicants request withdrawal of the double patenting rejection.

#### 4. RESTATEMENT OF JANUARY 9<sup>TH</sup> ARGUMENT WITH ADDITIONAL COMMENTS

For the completeness of the record, Applicants restate their January 9<sup>th</sup> argument while providing additional comments.

Applicants respectfully submit that the one-way obviousness analysis used by the PTO in the double patenting rejection is an improper analysis under the current circumstances. Applicants respectfully submit that the PTO should have applied a two-way obviousness test instead of the one way analysis because the '005 patent was issued from an application that was filed later than the present application. The reasons for the two-way obviousness test are explained, for example, the enclosed *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993):

In *In re Braat*, 937 F.2d 589, 593 (Fed.Cir.1991), this court required in certain circumstances, an additional inquiry to support the double patenting obviousness rejection. Under these circumstances, a double patenting obviousness rejection will only be sustained if the application claims are not patentably distinct from the prior patent claims, and the prior patent claims are also not patentably distinct from the application claims. **This “two-way” analysis is necessary because a later-filed improvement patent may issue before an earlier-filed basic invention.** *Id.*; see *Stanley*, 214 F.2d 151. (Bold emphasis added)

See also, the MPEP § 804.II.B.1(b):

“If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998)”

Applicants respectfully submit for the two-way obviousness test the following three conditions has to be satisfied:

1) a patent used in an obviousness type double patenting rejection should issue from an application, which has an actual filing date later than an application in question;

2) claims of the patent used in the obviousness type double patenting rejection and claims of the application in question could not have been filed in a single application;

3) an administrative delay occurred in the prosecution of the application in question and not through Applicants' fault.

Applicants respectfully submit that the present application satisfies all three conditions:

As for condition 1), the **actual** filing date of the '175 application, from which the '005 patent issue, is September 23, 2003, which is later than either of the two dates, which can be considered as an actual filing date of the present application, namely January 17, 2002, which a National Phase Entry date of the present application and August 10, 2000, which is the filing date of PCT/US00/21732.

As for condition 2), Applicants respectfully submit that claims of the '005 patent, including claim 10 of the '005 patent, could not have been filed in the present application because the present application does not provide a written description support for the claims of the '005 patent. If the PTO thinks otherwise, Applicants respectfully request for the PTO to provide references to particular places in the present specification, which, in the PTO's opinion, provide support to the elements of claim 10 of the '005 patent.

As for the condition 3, Applicants submit that an administrative delay in prosecution of the present application indeed did occur and not through the fault of the Applicants. In support, Applicants submit that the present application entered the US National phase on January 17, 2002, while the first Office Action on the merits, which was a Restriction Requirement, was mailed more than 41 months later on June 29, 2005. For comparison, U.S. application no. 10/669,175, from which the '005 patent was issued, was filed on September 23, 2003, and the first Office Action on the merits was mailed 21 months later on June 27, 2005.

Thus, the present application satisfies all the requirements for the two way obviousness analysis.

Applicants submit that the two way obviousness analysis, which is necessary under the present circumstances for a proper double patenting rejection, requires establishment of the following two *prima facie* cases of obviousness: 1) a *prima facie* case of obviousness of the pending claims over the claims of the '005 patent; and 2) a *prima facie* case of obviousness of the claims of the '005 patent over the pending claims.

Applicants respectfully submit that the PTO at least failed to establish the second *prima facie* case of obviousness. Applicants respectfully submit the claims of the '005 patent are non-obvious over the pending claims because one of ordinary skill in the art could not have predictably arrived at the claims of the '005 patent, which recite a method of screening for an inhibitor of HCV p7 protein, including steps (a)-(d) recited in all of the claims of the '005 patent, from any of the pending claims of the present application.

In sum, Applicants respectfully request withdrawal of the rejection.

#### CONCLUSION

Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith,

Atty. Dkt. No. 080618-0241

Appl. No. 10/031,145

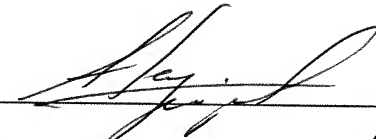
Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date April 29, 2009

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